

Docket No. : IMRAA.015C1/IM-72C
Application No. : 09/785,944
Filing Date : February 16, 2001

Customer No.: 20,995

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Martin E. Fermann
Appl. No : 09/785,944
Filed : February 16, 2001
For : MODE-LOCKED MULTI-MODE
FIBER LASER PULSE SOURCE
Examiner : Sayadian, Hrayr
Art Unit : 2814
Conf. No. : 7227

**INFORMATION DISCLOSURE STATEMENT AND
STATUS UPDATE ON RELATED LITIGATION**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed for filing in the above-identified application is a PTO/SB/08 Equivalent listing 5 references, all of which are submitted herewith.

Citation no. 1 on the PTO/SB/08 Equivalent is the civil docket for the litigation *IMRA America, Inc. v. IPG Photonics Corporation* discussed below. The docket includes lists of documents of record in the litigation such as, e.g., pleadings, motions, briefings, stipulations, transcripts, discovery documents including interrogatories and depositions, court orders, and other documents. The docket report was downloaded from the Public Access to Court Electronic Records (PACER) website (<http://www.pacer.gov>) on December 19, 2011. Citation no. 1 is referred to below as the "PACER Docket." Some of the documents listed in the PACER Docket have been previously submitted in Information Disclosure Statements.

Applicant is submitting the PACER Docket and providing the summary of the status of the litigation (below) to continue to bring to the attention of the Office the nature and existence

of this litigation, including allegations of invalidity, inequitable conduct, and questions of inventorship. Applicant is submitting the PACER Docket and providing the status summary below to inform the Office of the nature of these issues so that the Office can intelligently evaluate the need for asking for further materials in the litigation. M.P.E.P. 2001.06(c).

Status of Litigation

IMRA America, Inc. (“IMRA”) owns U.S. Patent No. 5,818,630 (the ‘630 Patent), which has the same inventors as the present application and is incorporated by reference therein. IMRA sued IPG Photonics Corporation (“IPG”) for infringement of the ‘630 Patent. The litigation, *IMRA America, Inc. v. IPG Photonics Corporation*, was filed in federal court in the Eastern District of Michigan on November 16, 2006 (Case No. 2:06-cv-15139). See, e.g., document nos. 1 and 4 in the PACER Docket.

Among its affirmative defenses, IPG alleged that:

1. IPG does not infringe the claims of the ‘630 patent;
2. the claims of the ‘630 patent are invalid because they fail to satisfy the conditions of patentability specified in one or more of 35 U.S.C. §§ 102, 103, 112, and 116;
3. the ‘630 patent is unenforceable against IPG pursuant to the doctrine of inequitable conduct; and
4. the ‘630 patent is unenforceable against IPG pursuant to the doctrine of patent misuse

See, e.g., document nos. 6 and 74 on the PACER Docket.

On December 27, 2010, after a *Markman* hearing held on June 2, 2010, the District Court issued an opinion and order adopting IMRA’s proposed construction of the term “mode converter.” See, e.g., document nos. 193, 194, and 195 on the PACER Docket.

Four summary judgment motions were filed by the parties, and a hearing for all four summary judgment motions was held on March 3, 2011. See, e.g., minute entry following document no. 212 on the PACER Docket.

On March 14, 2011, the District Court ruled on these four summary judgment motions. See, e.g., document no. 212 on the PACER Docket. The District Court’s opinion and order is

submitted as citation no. 2 on the PTO/SB/08 Equivalent. In the opinion and order, the District Court:

1. granted IMRA's Motion for Summary Judgment of No Invalidity for Derivation;
2. granted IMRA's Motion for Summary Judgment of No Inequitable Conduct;
3. denied IPG's Motion for Summary Judgment of No Infringement, Invalidity and No Willful Infringement; and
4. denied in part and granted in part IPG's Motion for Summary Judgment Regarding Damages Issues.

A jury trial began on September 26, 2011 before District Judge Arthur J. Tarnow. IMRA and IPG stipulated that the following claims and counter claims were dismissed from the case:

1. IPG's request for declaratory relief regarding invalidity under 35 U.S.C. §§ 102, 103 and 116;
2. IPG's request for declaratory relief that the '630 patent is unenforceable pursuant to the doctrines of patent misuse and laches; and
3. IMRA's claim that IPG has induced infringement of the '630 patent.

See, e.g., document no. 297 on the PACER Docket, which is submitted as citation no. 3 on the PTO/SB08/Equivalent.

On October 6, 2011, the jury reached a verdict of no infringement of the '630 patent by IPG, and the case was dismissed. See, e.g., document nos. 287 and 299 on the PACER Docket. The Amended Final Judgment by District Judge Tarnow dated November 21, 2011 is submitted as citation no. 4 on the PTO/SB08/Equivalent.

Pursuant to 35 U.S.C. § 290, on November 14, 2011, the clerk of the court submitted to the Director of the U.S. Patent and Trademark Office a Report on the Filing or Determination of an Action Regarding a Patent or Trademark, which is submitted as citation no. 5 on the PTO/SB08/Equivalent.

The submission of the listed documents is not intended as an admission that any such document constitutes prior art against the claims of the present application. Applicant does not waive any right to take any action that would be appropriate to antedate or otherwise remove any listed document as a competent reference against the claims of the present application.

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Page 4 of 4

The present application is undergoing appeal. Applicant respectfully requests consideration of the references listed herein; however, if the references cannot be considered prior to the disposition of the appeal, Applicant respectfully requests this Information Disclosure Statement and enclosed references be placed in the file pursuant to 37 C.F.R. § 1.97(i). No fee is required.

If the Examiner would like further documents or information regarding this ongoing litigation, the Examiner is requested to contact the undersigned attorney at his direct line (949) 721-7609.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: December 21, 2011

By: /Steven P. Ruden/

Steven P. Ruden, Ph.D.
Registration No. 53,538
Attorney of Record
Customer No. 20995
(949) 760-0404